

REMARKS

Claims 8-23 are pending. Claim 7 is rewritten as new claim 18. Claims 8-11, 14, and 15 are amended to depend from claim 18. New claims 19-23 find basis in paragraph 19 spanning pages 4-5.

Claims 7-16 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. While not necessarily agreeing with the rejection, in order to further prosecution, Applicants have rewritten claim 7 as new claim 18. The rejection is believed to be moot in view of this amendment.

Claims 7-16 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over WO 99/54524 ("the Newman application") in view of U.S. Patent No. 5,592,686 ("the Third patent"). Applicant respectfully traverses the obviousness rejection because a proper *prima facie* obviousness rejection under 35 U.S.C. § 103(a) has not been established.

To establish a proper *prima facie* rejection under 35 U.S.C. § 103(a), the Office must show:

- (1) the references are available as prior art against the claimed invention;
- (2) the motivation (explicit or implicit) provided by the references that would have rendered the claimed invention obvious to one of ordinary skill in the art at the time of the invention;
- (3) a reasonable expectation of success;
- (4) the basis for concluding that the claimed invention would have been obvious to do, not merely obvious to try; and
- (5) the references teach the claimed invention as a whole.

If any one of these elements is not established, a proper *prima facie* obviousness rejection cannot be made and the applicants are entitled to a patent. *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1983).

As admitted by the Office, the Newman application does not teach the use of a pore former material. Office Action at page 3. In an attempt to cure this defect, the Office recites the teaching of the Third patent. The use of a pore forming material in the Third patent, however, is an optional component. *See*, for example, the Abstract. Applicants submit that the importation of an optional component of the Third patent into the teachings of the

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Newman application would at most be obvious to try, not obvious to do. As such, Applicants respectfully request reconsideration and withdrawal of the rejection.

Furthermore, even when the optional pore former is utilized in the Third patent, there is no teaching for one to derive the limitations of the instant claims regarding a defined pore diameter between about 0.01 μm and about 50 μm and a tensile strength between about 5 and about 500 N/mm². For at least this reason, Applicants submit that the rejection should be withdrawn.

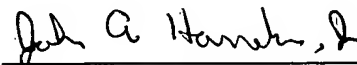
In regard to claim 10, there is no suggestion to use pore forming materials of different densities and/or sizes are suspended in the solvent to obtain a sintered metal layer with a graded layer structure. The Office asserts that natural variations in size would achieve this effect. Office Action at page 4. No evidence is presented, however, that shows that this would occur to a measurable extent. Absent such evidence, Applicants submit that the rejection should be withdrawn as applied to claim 10.

New claims 19-23 contain metallic fibers whose use is not obvious in view of the art.

Applicants believe the foregoing constitutes a complete response to the Office Action and submit that all pending claims are in condition for ready allowance. An early Office Action to that effect is, therefore, earnestly solicited.

Respectfully submitted,

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